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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/311,753	05/14/99	INOUE	T 054370

IM52/1219
SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE N W
WASHINGTON DC 20037

EXAMINER

BERNATZ, K

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED:

12/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/311,753

Applicant(s)

INOUE ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Amendments to the specification filed on November 30, 2000, have been entered in the above-identified application.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Mamish (U.S. Patent No. 5,227,225).

This rejection has been maintained and the basis for this rejection can be found in paper no. 7.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamish (225).

This rejection has been maintained and the basis for this rejection can be found in paper no. 7.

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4. Claims 1 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al. (U.S. Patent No. 6,037,054).

This rejection has been maintained and the basis for this rejection can be found in paper no. 7.

Response to Arguments

5. Applicant's arguments filed November 30, 2000 have been fully considered but they are not persuasive.

6. The rejection of claims 1, 3 and 4 under 35 U.S.C § 102(b)

Applicants have submitted that Mamish fails to teach the claimed invention. In particular, applicants address the issue that the invention disclosed by Mamish has the adhesive on the surface of the non-woven backing, with only a portion of the adhesive also anchored to the polyolefin backing layer. Applicants then maintain that when the adhesive is bonded to the non-woven backing, it can result in the adhesive layer becoming rough. Applicants' comparative example 4 illustrates such a case using a 20 μm PP film, a 40 g/m² PP non-woven fabric and a 5 μm PiB adhesive. The examiner respectfully disagrees.

Mamish discloses that the polyolefin backing layer impregnates the non-woven fabric (col. 1, lines 56 – 62). Mamish fails to disclose the percent of the fabric exposed to the adhesive, but it should be noted that the backing layer is from 1.5 – 2 mils (38 – 50 μm) thick (Table 1) and the adhesive is applied to be 0.7 – 2.0 mils (18 – 50 μm) (examples + claims). This is within the applicants' claimed ranges, (3 – 100 μm on

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page 11). Examiner maintains that since the non-woven fabric is impregnated to such an extent that the adhesive is in contact with the polyolefin backing layer and the thickness of the adhesive layer is greater than that used in applicants' comparative examples, the applicants have failed to provide evidence that the fibers of the Mamish invention result in roughening of the surface and, hence, failure to provide impermeability. The examiner also maintains that the structure of the Mamish invention appears the same as applicants' claimed invention, since the non-woven fabric used by applicants would also be partially impregnated and it is unclear whether applicants intend it to exist as a discrete layer.

7. The rejection of claims 1 – 4 under 35 U.S.C. § 103(a) – Mamish

Applicants argue the rejection of claim 2, claiming impermissible use of hindsight. The examiner respectfully disagrees.

The examiner would like to note U.S. Patent No. 5,246,773, also to Mamish, where Mamish discloses a similar tape structure (col. 1, lines 27 – 48) with a positive recitation of the non-woven fabric weighing $17 \text{ g/yard}^2 = 20.4 \text{ g/m}^2$ (example 1).

Applicants are also reminded that the invention should be compared to the closest prior art. Since all the comparative examples disclosed by applicants differ from the Mamish invention, the scope of applicants' claims encompass the Mamish invention. If applicants are attempting to show unexpected results, the showing must be commensurate with the scope of the claims and the claims need to be narrowed to reflect this.

8. The rejection of claims 1 –4 under 35 U.S.C. § 103(a) – Shirai

Applicants argue the rejection of claims 1 – 4 based on a failure of Shirai et al. to disclose a positive recitation of the use of a polymer film **and** a non-woven fabric. Applicants maintain that the novelty of their invention is the combination of the non-woven layer and the film layers. Applicants further state that Shirai et al. fails to teach applying the adhesive to the surface of the polymer film, rather than the non-woven fabric. The examiner respectfully disagrees.

Shirai et al. explicitly teaches applying the adhesive to the polymer film. The examples disclosed by Shirai et al. all deal with applying a PiB adhesive on a PP film (example 1). Shirai et al. mentions that non-woven fabrics are also useable as supports (col. 7, lines 33 – 42), and can hence be considered equivalent to the polymer film. It is old in the art to use multiple layers (see for example both Mamish references, which use “two-layer backing”). The courts have ruled that substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalence. *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v Linde Air Products Co.* 85 USPQ 328 (USSC 1950). Therefore, the examiner deems that one of ordinary skill in the art would have recognized that multiple layers could be used as the support, these multiple layers could be thin films, non-woven fabrics or a combination of the two, and the adhesive could be applied on either a thin film (as taught by Shirai et al.) or a non-woven fabric (as taught by Mamish).

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

KMB

KMB
December 14, 2000


STEVAN A. RESAN
PRIMARY EXAMINER